

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SANAA F. ABDELHADI, JACK ALLEN ALFORD JR.,
SANDIP A. AMIN, DAVID GLENN GROST, and JAMES LEE LENTZ

Application No. 09/965,002

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on October 15, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

APPEAL BRIEF

Summary Of Claimed Subject Matter

Appellants filed an Appeal Brief dated May 2, 2006, in response to the Final Rejection mailed August 12, 2005. The Appeal Brief is not in compliance with 37 C.F.R. § 41.37(c) effective September 13, 2004.

§ 37 C.F.R. § 41.37(c) states:

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under § 41.31.

* * *

(c)(1) The brief shall contain the following items...of this section:

(v) ***Summary Of Claimed Subject Matter.*** A concise statement of each ground of rejection presented for review.

An in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief. The Appeal Brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claims argued separately, every means plus functions and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with references to the specification by page and line number, and to the drawings, if any, by reference characters (37 C.F.R. 41.37(c)(1)(v)).

Section 37 C.F.R. § 41.37(c) further states:

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

When the Office holds the brief to be defective solely due to appellant's failure to provide a summary of the claimed subject matter as required by 37 C.F.R. § 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 C.F.R. § 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and § 711.02(b).

In addition, the Appeal Brief filed on May 2, 2006, on page 3, under the heading "Grounds of Rejection to be Reviewed on Appeal (VI)" the Appellants stated:

"Whether claims 1-37 were properly rejected under 35 U.S.C. § 103(a) as being upatentable over Joyce et al. in view of Ahmed et al."

In response, an Examiner's Answer was mailed on August 3, 2006. While the Answer notes that "the appellants' statement of the grounds of rejection to be reviewed on appeal is correct" [2], the Examiner's Answer and the Final Rejection mailed August 12, 2005, states that Joyce et al., Ahmed et al., Kimura, and Darland references were used for 35 U.S.C. § 103 rejections. The Appeal Brief omits the Kimura and Darland references in the "grounds of rejection to be reviewed on appeal" section.

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A clarification of the references to be applied in the rejection is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to hold the Appeal Brief of May 2, 2006 defective;
- 2) notify appellants to file a paper providing a summary of the claimed subject matter as required by 37 C.F.R. 41.37(c)(1)(v);
- 3) consider the paper providing a summary of the claimed subject matter as required by 37 C.F.R. 41.37(c)(1)(v);
- 4) to give a proper explanation of the references to be applied for the grounds of rejection; and
- 5) for such further action as may be appropriate.

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By: Patrick J. Nolan
PATRICK J. NOLAN
Deputy Chief Appeals Administrator
(571) 272-9797

PJN/rwk

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cc: IBM CORPORATION (VE)
C/O VOEL EMILE
P. O. BOX 162485
AUSTIN TX 78716